

### **REMARKS**

Applicants amend claims 1, 5, and 11 and claims 1-20 are pending in this application. Applicants respectfully request allowance of all the pending claims.

Applicants initially note with appreciation that the Examiner has allowed claims 17-20 and has identified allowable subject matter in claims 3, 4, 6-9, and 12-16. The reasons for allowance set forth by the Examiner refer only to some of the features in the independent claims, and are not the only reasons that all of the claims are allowable. Each of the independent and dependent claims include additional patentable features or combinations of features not mentioned by the Examiner.

#### **Claim Rejections – 35 U.S.C. §112**

The Examiner rejects claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which Applicants regard as the invention. In response, Applicants amend claim 5 to address the Examiner's rejection by changing "backrest mounting member" to "backrest mounting portion".

#### **Claim Rejections – 35 U.S.C. §102**

The Examiner rejects claims 1, 2, 5, 10, and 11 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,095,820 ("Hanagan").

Claim 1 recites a motorcycle including a frame and a mounting member coupled to the frame. The mounting member includes a top surface facing away from the frame, a bottom surface facing toward the frame, and a luggage rack mounting portion. The motorcycle also includes a seat and a luggage rack. The seat is mounted over a portion of the top surface of the mounting member to sandwich a portion of the mounting member between the seat and the frame. The seat is not positioned over said luggage rack mounting portion, and the luggage rack is mounted to the luggage rack mounting portion of the mounting member.

Claim 11 recites a motorcycle including a frame and a mounting member coupled to the frame. The mounting member includes a top surface facing away from the seat pan portion, a bottom surface facing toward the seat pan portion, and side surfaces extending between the top and bottom surfaces. The mounting member includes a backrest mounting portion defined in at least one of the side surfaces. The motorcycle also includes a seat and a backrest. The seat is

mounted over the top surface of the mounting member to sandwich a portion of the mounting member between the seat and the seat pan portion. The seat is not positioned over the backrest mounting portion, and the backrest is mounted to the backrest mounting portion of the mounting member.

Claim 1 specifies that the seat is not positioned over the backrest mounting portion and claim 11 specifies that the seat is not positioned over the luggage rack mounting portion. Because claims 1 and 11 include these related limitations, they are discussed together below.

Hanagan discloses a motorcycle including a frame (14) and seat assembly (12). As shown in Fig. 5, the seat assembly (12) includes a structural saddle (50), a seat cushion (70), and a seat cover (80) positioned over the structural saddle (50) and seat cushion (70). The structural saddle (50) includes a base (52) coupled to the frame (14) and a vertically-extending back (54) that, in combination with the cushion (70), defines the backrest. The vertically-extending back (54) includes a luggage rack mounting portion (66). A luggage rack frame member (94) is coupled to the luggage rack mounting portion (66) of the vertically-extending back (54) of the structural saddle (50). The lower portion of the frame member (94) defines a luggage rack (110). The Examiner also states that the backrest (54) is coupled to the backrest mounting portion (near arrow 50 in Fig. 5) of the structural saddle (50).

The Examiner is comparing a structural saddle of a seat assembly to the mounting member of the claims. One of ordinary skill in the art would understand that a seat, as claimed in claims 1 and 11, includes a seat cushion and structural saddle. Because the seat is claimed separate from the mounting member in claims 1 and 11, Applicants respectfully submit that the Examiner cannot use part of the seat to also satisfy the mounting member limitation of the claim. Each of the claimed elements is unique and therefore, Applicants respectfully submit that both limitations cannot be satisfied by the same structural member.

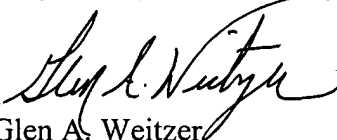
Even if the Examiner disagrees with the above argument, Applicants have amended the claims to clarify the distinction between the structural saddle of the seat and the claimed mounting member. Specifically, the claims have been amended to specify that the seat is not positioned over the mounting portions of the mounting member. For example, the luggage rack mounting portion of the illustrated embodiment of the invention extends rearwardly from the seat and therefore the seat is not positioned over the luggage rack mounting portion. Likewise, the backrest mounting portion of the illustrated embodiment of the invention extends downwardly

from the seat and therefore the seat is not positioned over the backrest mounting portion. In contrast, the seat of Hanagan is positioned directly over both the luggage rack mounting portion and the backrest mounting portion of the mounting member. Therefore, Hanagan does not teach or suggest the subject matter defined by independent claims 1 and 11.

Accordingly, independent claims 1 and 11 are allowable. Claims 2-10 and claims 12-16 depend from allowable independent claims 1 and 11, respectively, and are therefore allowable for the same and other reasons.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,



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